

**REMARKS**

In accordance with the foregoing, claims 18-21 have been added. No new matter has been entered. Therefore, claims 1-21 are pending and reconsideration of claims 1, 2, 5-7, 11-16 and consideration of claims 18-21 is respectfully requested.

**REJECTIONS UNDER 35 U.S.C. §103:**

Claims 1, 2, 5-7 and 11-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over prior art FIGS. 1-4B contained in this application. These rejections are traversed.

Regarding the rejection of claim 1, it is noted that claim 1 recites a driving apparatus comprising a blade on which an object is mounted, a servo-mechanism to drive the blade in a plurality of directions, and a plurality of elastic support members, to support the blade, the elastic support members being elastically movable with respect to the blade and located outside of the servo-mechanism. The plurality of elastic support members are grouped into pairs of elastic support members, a member of the pair arranged to face another member of the pair with respect to a center of rotation of the blade, and distances between the elastic support members in the respective pairs are substantially equal. As such, the claimed apparatus provides an improved structure to support the blade during the driving.

FIGs. 1-4, on the other hand, are representations of prior art devices in which a compression force acts on wires W2 and W5 causing them to buckle. The buckling of these wires creates instability in the entire system controlling the position of the objective lens 1. According to the Office Action, however, the claimed plurality of elastic support members being grouped into pairs could be interpreted to mean that the claimed invention included two or four elastic support members and that, therefore, it would have been obvious to simply remove wires W2 and W5 from the device of the prior art to "arrive at the device as claimed." Applicants respectfully disagree with this analysis.

Initially, applicants note that the claimed invention could not be understood as including only two elastic support members. This is facially clear from the language of the claim where it is noted that the elastic members are grouped into pairs, as opposed to a pair. Since each pair includes two elastic support members and there are at least two pairs, it is impossible that the claimed invention recites only two elastic support members.

As far as the notion that the prior art device could be modified so as to have wires W2 and W5 removed, applicants assert that the Examiner has not provided a motivation for the suggested modification other than stating that the suggested modification is a solution to the problem pointed out by the applicants. Responsively, applicants note that it is well settled that there must be some teaching, suggestion, or motivation to modify the prior art so found either

explicitly or implicitly in the references themselves. See *MPEP 2143.01*. Applicants submit that there is no evidence that the problem was even known until it was discussed in the specification of the current application.

Further, the MPEP additionally sets forth that the examiner must "forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." See *MPEP 2141.01(III)* (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). To this end, when justifying an obviousness rejection, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

As such, applicants respectfully assert that by suggesting a modification of the prior art discussed in the specification to cure a problem noted in the specification, the examiner is improperly justifying the obviousness rejection by employing the benefit of hindsight provided by the specification. Indeed, the examiner fails to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.

Thus, applicants further assert that the obviousness rejection of claim 1 is improper and, therefore, overcome.

Regarding the rejections of claim 5, 11, 13 and 15, it is noted that these claims recite similar features as claim 1 and that, therefore, these rejections are overcome for substantially the same reasons as set forth above.

Regarding the rejections of the dependent claims, it is noted that these rejections are overcome for substantially the reasons as set forth above.

#### **ALLOWABILITY OF CLAIMS 18-21:**

Applicants note that claims 18-21 correspond significantly to claims 1, 5, 11, 13 and 17 except that the new claims each recite at least three pairs of elastic support members. Therefore, the new claims are patentably distinguished from the suggested modification of the prior art and are, therefore, believed to be allowable.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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